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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/546,824	08/24/2005	Kazunori Okada	070456-0091	3179
20277 7590 12/15/2008 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096				
EXAMINER				
ROE, JESSEE RANDALL				
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1793				
MAIL DATE		DELIVERY MODE		
12/15/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/546,824

**Applicant(s)**

OKADA ET AL.

**Examiner**

Jessee Roe

**Art Unit**

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 1-3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

**DETAILED ACTION*****Status of the Claims***

Claims 1-3 and 5 are pending wherein claims 1-3 are amended; claim 4 is canceled; and claim 5 is withdrawn from consideration.

***Status of Previous Rejections***

The previous rejection of claims 1-4 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention is withdrawn in view of the Applicant's amendments to claim 1. The previous rejection of claims 1-3 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Roberts (US 4,021,271) is withdrawn in view of the Applicant's amendments to claim 1. The previous rejection of claims 1-3 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Doyle (US 3,310,389) is withdrawn in view of the Applicant's amendment to claim 1. The previous rejection of claim 4 under 35 U.S.C. 103(a) as being unpatentable over Doyle (US 3,310,389), and further in view of Glass et al. (US 5,306,414) is withdrawn in view of the Applicant's amendment to claim 1.

***Claim Objections***

Claim 1 is objected to because of the following informalities: In line 9 of claim 1, "said a nickel-manganese alloy" should be changed to "said nickel-manganese alloy". Appropriate correction is required.

Art Unit: 1793

Claims 2-3 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

With respect to the recitation "wherein said metal structure is formed of at least two kinds of metal material" in lines 1-2 of claim 2, the Examiner notes that in line 7 of claim 1, the metal structure is defined as a nickel-manganese alloy (two metals) which is more narrow than "two kinds of metal material". Therefore, claim 2 fails to further limit claim 1.

With respect to the recitation "wherein said metal structure is a microstructure", the Examiner notes that in line 11 of claim 1, "a crystal size of said contact probe after annealing is not more than 130 nm". Thus, the structure of claim 1 is nanostructure which would not be further limited by a microstructure as in claim 3.

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Haga et al. (US

Art Unit: 1793

2004/0104739).

In regards to claim 1, Haga et al. ('739) discloses a nickel-manganese alloy contact probe comprising a plunger portion in contact with a circuit to be tested; a spring portion supporting the plunger portion; and a lead line electrically connected to the spring portion (First Embodiment, [0035-0042]). Haga et al. ('739) further discloses that the crystal size of the nickel-manganese alloy is not more than 70 nm [0042].

With respect to the recitation "annealing has been applied at a temperature of 150°C-250°C, not more than a temperature at which crystals of said a nickel-manganese alloy start to become larger" in lines 8-10 of claim 1, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. MPEP 2113.

In regards to claim 2, Haga et al. ('739) discloses two kinds of metal material (i.e. nickel and manganese) (First Embodiment, [0035-0042]).

With respect to the recitation "annealing has been applied at a temperature not more than the temperature at which crystals of the metal material start to become larger" in lines 2-4 of claim 2, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not

Art Unit: 1793

depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. MPEP 2113.

With respect to the recitation "wherein said metal structure is a microstructure" in claim 3, the Examiner notes Haga et al. ('739) discloses that the crystal size of the nickel-manganese alloy is not more than 70 nm [0042] and claim 1 recites "a crystal size of said contact probe after annealing is not more than 130 nm". Therefore, because the structure disclosed by Haga et al. ('739) and the instant invention have the same or substantially the same size, it would be expected that the structure of Haga et al. ('739) would also be a microstructure.

### ***Response to Arguments***

Applicant's arguments with respect to claim 1-3 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jesse Roe whose telephone number is (571) 272-5938. The examiner can normally be reached on Monday-Friday 7:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1793

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Sheehan/  
Primary Examiner, Art Unit 1793

JR